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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/667,420	09/21/2000	Mariko Okamoto	07336.0003-00000	8873

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EXAMINER

FUBARA, BLESSING M

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/667,420

Applicant(s)

OKAMOTO ET AL.

Examiner

Blessing M. Fubara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on paper no. 14.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Examiner acknowledges receipt of paper number 14 filed 04/22/02.

#### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-021227 and McEleney et al. (US 5,567,420).

JP 11-021227 discloses a gel composition comprising 1.0-80.0 weight percent polyacrylamide, Vaseline or ceresin, 0.1-20.0 weight percent polyoxyethylene sorbitan fatty acid ester as the non-ionic surfactant and organopolysiloxane (abstract). Applicants admitted on page 3 of the remarks filed 11/15/01 that pigments and fillers may be used in Takeshi's composition and thus Takeshi's composition may comprise pigments and fillers. The JP reference in the translation provided by applicants suggests that pigments and fillers may be used in the gel composition.

McEleney discloses a skin care composition. The composition comprises formulations selected from the group consisting of lotions, **gels**, creams, moisturizers, mousses and ointments. The formulation comprises petrolatum, pigments, polyoxyethylene sorbitan fatty acid ester, anionic surfactants, polyacrylamide, preservatives and sunscreens agents. McEleney teaches polyacrylamide as a thickener and as a film former in amounts of from 0.1-10%. See abstract,

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column 5, lines 3-8, column 6, lines 30-67, column 8, lines 1- 45 and claims 10, 16, 17, 24 and 32.

The teachings of both references are directed to cosmetic composition. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of JP 11-021227 in the manner disclosed by McEleney. One having ordinary skill in the art would have been motivated to prepare a third composition comprising polyacrylamide, non-ionic surfactant, pigments, petrolatum, Vaseline or ceresin, organopolysiloxane, preservatives and sunscreens agents by combining the two compositions taught individually in the prior art for the same very cosmetic purpose. The expected result from the combined teachings of the reference is a composition comprising 1.0-80% polyacrylamide, , Vaseline or ceresin. 0.1-20.0 weight percent polyoxyethylenesorbitan fatty acid ester as the non-ionic surfactant, organopolysiloxane, petrolatum, pigments, preservatives and sunscreens agents.

**“It is prima facie obvious to combine two compositions each of which is taught by the art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose....[T]he idea of combining them flows logically from their having been individually taught in the prior art.” In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).**

Although the prior art is silent on treating the surface of the pigments and fillers, in the absence of unexpected results, one of ordinary skill in the art would expect the untreated surface of a pigment or filler to provide similar results as the treated surface. In general, where a

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composition is taught in the prior art, applicants must provide a showing of unexpected result for surface treated pigment or filler over a pigment or filler whose surface is untreated.

2. Applicants' cooperation is requested in correcting any errors of which applicants may become aware in the specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is 703-308-8374.

The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Blessing Fubara  
May 5, 2002

THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600